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10/556,825

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Jean Paufigue

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466 7590 06/22/2010

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EXAMINER

CHANNAVAJJALA, LAKSHMI SARADA

ART UNIT

PAPER NUMBER

1611

NOTIFICATION DATE

DELIVERY MODE

06/22/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

| | | | |
|------------------------------|---|---------------------------------------|--|
| Office Action Summary | Application No. 10/556,825 | Applicant(s) PAUFIQUE, JEAN | |
| | Examiner Lakshmi S. Channavajjala | Art Unit 1611 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-8 and 12-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt of amendment and response dated 3-22-10 is acknowledged.

Claims 1-8 and 12 -16 are pending in the instant application.

Claims 9-11 and 17 have been canceled.

The following rejections of record have been withdrawn in light of the amendment:

1. Claims 1-8 and 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Instant claim 1 fails to recite to what the instant composition is applied, which renders the claim vague and indefinite. Claims 2-8 and 12-16 are dependent on claim 1 and hence rejected.

Examiner notes that claim 16 spelled the word “chymotrypsin” as “chymotrypsin”.

The following is a new rejection in light of the amendment:

Claim Objections

2. Claims 13 is objected to under 37 CFR 1.75(c), as being improper dependent form because claim 13 is dependent from a canceled claim.

3. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to which independent claim is claim 13 dependent upon. For examination purposes, claim 13 is assumed to be dependent upon claim 1. If applicants disagree with the interpretation, a correction is requested.

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The following rejection of record is maintained:

4. Claims 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 recites the terms “low degree of polymerization” and “high degree of polymerization”, which is vague and indefinite because applicants have not described in the instant specification as to what is construed as a “high” or “low” degree of polymerization.

5. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Instant claim 12 recites that the active material obtained from chestnut meal should contain three glucide fractions: 1) Polysaccharide fraction: rhamnogalacturonan, 2) Oligosaccharide fraction with a high degree of polymerization and free uronic acids, and 3) A mono- and oligosaccharide fraction of a low degree of polymerization.

Response to Arguments

6. Applicant's arguments filed 3-22-10 have been fully considered but they are not persuasive.

7. Applicants argue that the full terminology is “Oligosaccharide fraction with a high degree of polymerization and free uronic acids, and a mono- and oligosaccharide fraction of a low degree of polymerization.” The fraction with the low degree of

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polymerization is thus defined as containing monomers (the lowest degree of polymerization) whereas the fraction with the high degree of polymerization would be recognized by one of skill as being free from monomers. The limitation in toto is thus clear on its face. Applicants' arguments are not clear because the above statement, "Oligosaccharide fraction with a high degree of polymerization and free uronic acids, and a mono- and oligosaccharide fraction of a low degree of polymerization", does not constitute a definition because the said description does not give at least an approximate number of repeating units of oligosaccharides that constitute monosaccharide. Without a distinction between the number of repeating units, it is possible that there is no difference between the oligosaccharides with low and high degree of polymerization. MPEP 2175.03(b) [R-6] states that The phrases "relatively shallow," "of the order of," "the order of about 5mm," and "substantial portion" were held to be indefinite because the specification lacked some standard for measuring the degree intended and, therefore, properly rejected as indefinite under 35 U.S.C. 112, second paragraph. *Ex parte Oetiker*, 23 USPQ2d 1641 (Bd. Pat. App. & Inter. 1992). Further, the description that the fraction with the low degree of polymerization is thus defined as containing monomers (the lowest degree of polymerization) whereas the fraction with the high degree of polymerization would be recognized by one of skill as being free from monomers, does not reflect that the low degree polymerization comprises free uronic acids. Absent any free uronic acids, degree of polymerization is not clearly identified so as to distinguish the two fractions. Applicants have not provided any literature evidence to show that a skilled artisan would be able to readily determine

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the meets and bounds of the instant claims. Or the same reason, the examiner maintains the position that the specification does not reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed method of treatment with the claimed chestnut meal having the requirements of claim 12.

Claim Rejections - 35 USC § 102

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1-8, 12, 13 and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by US 3,170,916 to Dziengel et al (Dziengel) and further as evidenced by Van der Haar.

10. Dziengel discloses a method of producing durable saponin containing extracts from chestnuts and products obtained therefrom. It is suggested that while the extracts of chestnuts have long been known for their therapeutic and cosmetic effects, restricting the water content of the meal improves the skin diffusion (col. 4, L 31-47). Dziengel teaches that the composition is useful for tightening of skin, acne, blemishes etc (col. 2, L 5-16). The process involves extracting an active agent from the chestnut using solvents such as propylene glycol (col. 2, L 19-30), particularly for saponines, flavanols etc. Instant claims do not state what the active agent is and hence can include the active agent of Dziengel. With respect to the activities or the specific use claimed in each of the claims 3-7, while Dziengel does not mention the claimed uses, neither the instant specification nor instant claims state what the actual ingredient is that enables

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the claimed effect. On the other hand, Dziengel teaches extraction of chestnut meal and therefore it is the position of the examiner that the active agents in the chestnut meal of the Dziengel possess the claimed uses of instant claims 3-7. The dry content of the extract is 15-25 grams dry weight (col. 3, L 7-11). The composition of Dziengel is combined with other components employed in cosmetic compositions and applied as packs, embrocations and otherwise (col. 4, L 48-50). With respect to the sugar content of claim 13, while Dziengel does not state the amount of sugar, Van de Haar (abstract of the article on Saponins, 1923) shows that hydrolysis of chestnut seed saccharides result in about 23% glucose, and other sugars such as pentose, galactose, glucuronic acid etc. Thus, it is the position of the examiner that the chestnut meal of Dziengel contains sugars in the claimed range and the burden is on applicants to show otherwise. While Dziengel is silent regarding the pH of the extract, it is the position of the examiner that the chestnut meal of Dziengel would inherently possess the claimed pH because the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtains prior art products and makes physical comparisons therewith." In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). Thus, Dziengel anticipates instant claims.

Claim Rejections - 35 USC § 103

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 3,170,916 to Dziengel et al (Dziengel) and further as evidenced by Van der Haar, in view of US 4,800,080 to Grollier et al.

13. Instant claim requires that the cosmetic composition is in the form of an aqueous emulsion, an alcoholic emulsion, a lotion, a cream with an aqueous base, a cream with a fatty base, and an ointment. Dziengel fails to disclose the claimed forms.

14. Grollier teaches cosmetic compositions comprising saponins extracted from various plant materials including chestnuts (col. 3, L 14-21). Grollier suggests that the composition containing the above chestnut and other plant extracts may be in the form of lotions or gels in the form of aqueous or aqueous alcoholic extracts (col. 10, L 14-22). Thus, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention was made to prepare a cosmetic composition with the chestnut extract of Dziengel, in a suitable form such as emulsion which is aqueous or alcoholic with an expectation to provide the maximum availability of the active ingredient in chestnut extract from the preparation when applied to skin for its desired properties (moisturizing suggested by Dziengel or conditioning property suggested by Grollier).

Response to Arguments

15. Applicant's arguments filed 3-22-10 have been fully considered but they are not persuasive.

16. Applicants argue that the present invention pertains to a specific cosmetic treatment directed at improving the barrier effect on skin. The present invention uses a particular active ingredient: a chestnut meal extract. DZIENGEL pertains to obtaining saponin from horse chestnut extracts. A horse chestnut extract is different from the chestnut extract of the present invention. Applicants state that horse chestnut is *Aesculus hippocastanum* and chestnut is *Castanea sativa*.

17. Applicants' arguments are not persuasive because neither the claims examined nor the instant specification describes that the claimed chestnut does not include horse chestnut. Applicants have not provided any description as to the botanical name of the plants from which the claimed chestnut meal is obtained. During patent examination, the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). Claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). In *re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). In this regard, the specification only mentions chestnut meal and as explained above does not provide the source. Accordingly, the scope of the claimed term "chestnut meal" encompasses horse chestnut of the Dziengel reference.

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18. Applicants argue that the reference does not describe specifically treating dry skin by means of multiple actions. Applicants' arguments are not persuasive because instant claims only require the composition to be applied to the skin and the limitations of claims 2-8 is an associated property of the chestnut meal. Dziengel teaches that the composition is useful for tightening of skin, acne, blemishes etc. Applicants arguments without any evidence to show the absence of the activities claimed are not persuasive.

19. It is argued that saponins are present in chestnuts, but because of their specific structure, saponins are poorly soluble in water. So it is argued that saponins can't be in the extract of the present invention's extract, which is obtained via aqueous extraction.

Thus, they argue that the extracts of the present invention do not contain saponins.

Applicants' arguments are not persuasive because instant claims do not exclude saponins and further, the claims neither recite the process of production nor require the composition to contain soluble fractions. The above rejection clearly provides support to show that with respect to the sugar content of claim 13, while Dziengel does not state the amount of sugar, Van de Haar (abstract of the article on Saponins, 1923) shows that hydrolysis of chestnut seed saccharides result in about 23% glucose, and other sugars such as pentose, galactose, glucuronic acid etc. Thus, it is the position of the examiner that the chestnut meal of Dziengel contains sugars in the claimed range and the burden is on applicants to show otherwise. Applicants have not provided any arguments regarding the sugar content. The argument that Van de Haar does not teach cosmetic application is not persuasive because the reference is cited as an evidence for sugars and the teachings of Dziengel include cosmetic applications.

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20. Applicants argue that Grollier teaches dosage forms (creams, lotions) but does not teach the deficiencies of Dziengel in light of Van der Haar discussed above.

Applicants' arguments are not persuasive because the arguments regarding Dziengel in light of Van der Haar have been addressed and as admitted, Grollier is only cited for dosage forms. Further, in response to applicant's argument the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM -5.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila G. Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lakshmi S Channavajjala/
Primary Examiner, Art Unit 1611
June 17, 2010

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